

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendments, claims 1, 2, 9, 10, 11, 12, 13-25, 28, 33-41, 43-46, 51, 53-56, 64, 65, 66 and 70 are pending in the application, with claims 1, 53 and 54 being the independent claims. Claims 1, 53, and 54 are currently amended. Support for these amendments can be found throughout the specification, e.g., at pages 3-4, 7-8, and 10-15.

Claims 59, 68, and 69 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 3-8, 26-27, 42, 57, 62-63, and 67 remain cancelled without prejudice to or disclaimer of the subject matter therein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objections to the Claims

Claims 49, 50, 60 and 61 remain objected to because these claims currently depend from a rejected base claim. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 49 depends from claim 47, which depends from claim 40, which depends from claim 1. Claims 50 depends from claim 47. Claims 60 and 61 depend from claims 1, 53 and 54. Claims 1, 53 and 54 are independent claims. However, in light of the

amendments presented herein, the rejection of claims 1, 40, 53 and 54 is moot.

Therefore, Applicants respectfully request reconsideration and withdrawal of the objection to claims 49, 50, 60 and 61.

Rejections under 35 U.S.C. § 103

The Examiner issued three rejections under 35 U.S.C. § 103(a). First, claims 1, 2, 9, 10, 11, 12, 13-25, 28, 33-41, 43-46, 51, 53-56, 59, 64, 65, 66, 68, 69 and 70 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ts'o *et al.* (*Urology*, 49: 881-885 (1997)), in view of Galbraith *et al.* (*Cytometry*, 12: 579-596 (1991)) and Waggoner *et al.* (*Human Path.*, 27: 494-502 (1996)).

Second, claims 1, 2, 9, 10, 11, 12, 13-25, 28, 33-41, 43-46, 51, 53-56, 58, 59, 64, 65, 66, 68, 69 and 70 remain rejected as allegedly being unpatentable over Ts'o *et al.* (*Urology*, 49: 881-885 (1997)), in view of Galbraith *et al.* (*Cytometry*, 12: 579-596 (1991)) and Waggoner *et al.* (*Human Path.*, 27: 494-502 (1996)), and further in view of Ross (US 5,674,694).

Finally, claims 1, 2, 9, 10, 11, 12-25, 28, 33-41, 43-47, 51, 53-56, 59, 64, 65, 66, 68, 69 and 70 remain rejected as allegedly being unpatentable over Ts'o *et al.* (*Urology*, 49: 881-885 (1997)), in view of Galbraith *et al.* (*Cytometry*, 12: 579-596 (1991)) and Waggoner *et al.* (*Human Path.*, 27: 494-502 (1996)), and further in view of Takeda *et al.* (*Cancer*, 77: 934-940 (1996)). Applicants respectfully traverse all of the Examiner's rejections for the reasons provided in prior replies.

The Examiner stated in the Office Action that "method claims drawn to the detection of circulating epithelial cells other than prostate cells would be allowable." *See* page 9. Solely to expedite prosecution, Applicants have amended the claims

accordingly. When an applicant discloses and teaches how to make and use a genus and species therewithin, amending the claims to exclude two of the species meets the written description requirement. *In re Johnson*, 194 USPQ187 (CCPA 1977); *see also, In re Driscoll*, 195 USPQ 434 (CCPA 1977). Therefore, Applicants respectfully request that the rejections under 35 U.S.C. § 103(a) be withdrawn.


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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